Supreme Court, U.S.
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No. 02-262

IN THE

Supreme Court of the United States

TECHSEARCH, L.L.C.,

Petitioner,

v.

INTEL CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED FOR REVIEW

TechSearch's Petition raises two questions that it contends are worthy of Supreme Court review. To facilitate straightforward analysis of the Petition, Intel distills out the essence of those questions from TechSearch's presentation and restates them as follows:

1. Whether the Federal Circuit's decision to apply regional circuit law, instead of Federal Circuit law, to review a trial court's use of a technical advisor, improperly interferes with the uniform application of patent law or Federal Rule of Evidence 706?

2. Whether a litigant is denied a right to a jury trial as a result of the District Court's use of a non-testifying technical advisor when the District Court and the Federal Circuit both reached the conclusion, on several independent grounds, that the party did not place into the summary judgment record evidence that raises a genuine dispute of material fact?

STATEMENT PURSUANT TO RULE 29.6

Respondent, Intel Corporation, has no parent corporation and no publicly held company owns 10% or more of its stock.

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STATEMENT OF THE CASE

Intel disagrees with TechSearch's Statement of the Case, and incorporates the Federal Circuit's statement of the case as a more balanced statement. App. 12-23, 25-27, 29-37 & 42-45. In addition, TechSearch makes a number of statements about the record that demand clarification.

First, TechSearch contends that the technical advisor was "simply turned loose to act as both judge and fact-finder, with no supervision whatever." Petition at 9. This speculative assertion ignores the carefully crafted order issued by the District Court which ensured that the technical advisor performed only within the confines of his limited role. App. 47-53.

Second, TechSearch contends that, although the technical advisor executed a declaration stating that he would abide by all of the District Court's restrictions, he did not execute a declaration at the end of the case restating and confirming compliance with that commitment. However, this argument assumes that the case is over. In fact, the parties are currently litigating over attorneys' fees in the District Court, and this involves a host of substantive technical issues. Because the case is not complete, TechSearch's argument that the technical advisor has "failed" to submit a declaration should be rejected.

Third, TechSearch places great weight on the technical advisor's use of the terms "research" and "research discussions" on his invoice to suggest that he performed some kind of improper investigation. This attempt to impute pernicious meaning to innocuous language on a timesheet is exactly the type of unsubstantiated accusation that the courts have repeatedly rejected in this context. In any event,

TechSearch has been utterly unable to identify any "research" that could conceivably be prejudicial. One cannot crack open an Intel microprocessor like a peanut and view anything meaningful relative to the case. In any event, the summary judgment record either discloses material evidence or it does not. Even if the technical advisor did search somewhere outside that record for something, which there is no evidence that he did, that could not change the absence of evidence from TechSearch to prove its case. TechSearch's argument simply ignores the nature of the summary judgment process.

Fourth, TechSearch represents unqualifiedly that it "objected" to the appointment of the technical advisor. Petition at 4. In fact, TechSearch did not object when the appointment order was entered on November 9, 1999, and waited *over* a month to object, doing so only on December 16, 1999, two days *after* the hearing on Intel's motion for summary judgment and *after* the District Court announced its intention to grant Intel's motion for summary judgment of non-infringement. *Compare* App. 95-96 *with* Respondents Appendix 1a-2a. When it did finally object, TechSearch failed to identify any basis for its objection at all. App. 7460-62. Wait and see tactics such as those employed by TechSearch have been severely criticized by courts in precisely this context for good reason:

> In our view, when a trial judge announces a proposed course of action which litigants believe to be erroneous, the parties detrimentally affected must act expeditiously to call the error to the judge's attention or to cure the defect, not lurk in the bushes waiting to ask for another trial when their litigatory milk curdles.

Reilly v. United States, 863 F.2d 149, 160 (1st Cir. 1988). Thus, as in *Reilly*, TechSearch waived its objection and this defect also supports denial of the Petition.

SUMMARY OF THE ARGUMENT

TechSearch's Petition, like many attempts to provoke Supreme Court review, is a tale plagued by legal and factual overstatement, further distorted by overheated rhetoric. As demonstrated below, none of TechSearch's arguments has merit, much less is so extraordinary that it would justify Supreme Court review.

First, the Federal Circuit's application of regional circuit law, instead of Federal Circuit law, to the use of a technical advisor is proper because the management of technical advisors is not an issue unique to patent law. The Federal Circuit's well-established policy of deferring on such issues to the law of the regional circuits reflects appropriate comity for its sister courts of appeals, and does not interfere with the uniformity of patent law. In fact, the appellate courts have ruled with remarkable consistency in this area based on this Court's decision in *In re Peterson*, 253 U.S. 300, 312-13 (1920) (Brandeis, J.), which affirms the inherent authority of courts to appoint technical advisors. In its Petition, TechSearch fails even to address this key case, even though it is the most prominent statement by this Court on the subject of the Petition.

Second, TechSearch's attempt to create conflicts among the lower court decisions simply cannot survive a reading of the cases. TechSearch cites a host of cases, but most do not relate to technical advisors at all (relating instead to testifying experts or Special Masters), and the remainder are perfectly consistent with this Court's ruling in *In Re Peterson*.

Third, TechSearch's attempt to find conflict with Federal Rule of Evidence 706 is equally unsuccessful. On its face, Rule 706 governs only *witnesses* who submit evidence in the record, not technical advisors who are forbidden from contributing evidence to the record. TechSearch's Petition cites no authority contrary to this understanding of Rule 706. Yet, TechSearch nevertheless ignores this basic principle. It is undisputed that the technical advisor in this case did *not* contribute any evidence into the summary judgment record whatsoever; thus, Rule 706 never applied. TechSearch's reading of Rule 706 not only ignores its text, but would suffocate the long-established inherent authority of district courts to retain technical advisors where needed.

Finally, TechSearch's assertion that it was improperly deprived of a jury trial ignores the fact that there simply was no evidence in the record sufficient for it to prove its case. Indeed, the well-established *role* of summary judgment is to deny a "right" to a jury trial where a party has failed to submit evidence that could support a jury verdict in its favor. The existence of a technical advisor can not and did not affect whether there was evidence in the documentary summary judgment record that raises a genuine dispute of material fact.

As with its legal analysis, TechSearch's description of what happened in the District Court strays sharply from the record. In fact, the Federal Circuit was correct in stating that the District Court's seven page order appointing the technical advisor included substantial safeguards, such as a bar preventing the technical advisor from contributing evidence or performing independent investigation. TechSearch's overheated attacks on the District Court and the technical advisor simply lack support in the record, as the Federal Circuit found. For example, TechSearch irresponsibly

suggests that the technical advisor performed improper "experiments" with computer equipment he purchased, and describes this as perhaps "most important." Petition at 8, 9. In reality, TechSearch's entire argument stems from entries on the technical advisors' credit card bill for which he did *not* request reimbursement. The credit card bill was submitted merely so he could recover for one line-item, a $10 telephone call made to the judge. It is absurd to suggest that the purchase of over-the-counter products at a computer superstore is sufficient evidence that the technical advisor was performing experiments that could conceivably be relevant to the issues in this case, which involve the nano-level specifics of the internal design of a microprocessor. Indeed, given the nature of the summary judgment process, which entails a review of a fixed documentary record, the allegation that some kind of experimentation could have affected the outcome in this case is even more strained.

In sum, TechSearch lost its case because the patent-in-suit was so different from the accused products that no reasonable jury could have found that there was patent infringement for multiple, independent reasons. TechSearch does not even attempt to show why every judge that has reviewed the matter was wrong in concluding that TechSearch failed on the *merits* of this case. TechSearch's attempt to blame its failure of proof on the decision making procedures of the Federal Circuit or the District Court is meritless and is not worthy of Supreme Court review. Each of these issues is addressed below.

REASONS FOR DENYING THE PETITION

I. THE FEDERAL CIRCUIT'S DECISION TO APPLY REGIONAL CIRCUIT LAW TO THE USE OF TECHNICAL ADVISORS IS NOT WORTHY OF SUPREME COURT REVIEW

A. Supreme Court Review Is Not Necessary Or Appropriate To Achieve Uniformity In Patent Law

TechSearch argues that the Federal Circuit should have applied Federal Circuit law — instead of regional circuit law — to its review of the District Court's use of a technical advisor. According to TechSearch, Federal Circuit law should govern this issue to maintain the uniformity of patent law. Petition at 12-13. As established below, TechSearch's position fails for many reasons.

It is well-established that the Federal Circuit reviews "procedural matters, that are not unique to patent issues, under the law of the particular regional circuit court where appeals from the district court would normally lie." *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984), *overruled on other grounds, Richardson Merrell, Inc. v. Koller*, 472 U.S. 424 (1985); *see also Zodiac Pool Care, Inc. v. Hoffinger Indus.*, 206 F.3d 1408, 1416 (Fed. Cir. 2000) ("this court defers to the law of the regional circuits on matters of procedural law."). Among other things, this rule avoids the need for the hundreds of district court judges around the country to learn and apply a different set of procedural rules in patent cases than they would normally apply in all their other cases. *Panduit*, 744 F.2d at 1574-76.

Below, the Federal Circuit applied this long-standing rule in what should be a non-controversial way. The Federal Circuit correctly concluded that there is nothing about the procedure for retaining a technical advisor that is unique to patent law:

> Procedural rulings are reviewed by this court under regional circuit law, the Ninth Circuit in this case, unless the procedural issues are unique to patent law. Further, "we apply regional circuit law to procedural issues that are not themselves substantive patent law issues." The procedural issue, namely the use of a technical advisor to assist the district court in understanding complex scientific and technical factual issues, is not limited to and unique to patent cases. Technical advisors may be useful for the understanding of scientific evidence generally as well as the science or technology involved in patent cases. **Because understanding issues of complex science and technology is not so unique as to clearly implicate the jurisdictional responsibilities of this court in a field within its exclusive jurisdiction, we apply regional procedural law.**

App. 37-38 (citations omitted) (emphasis supplied).

TechSearch does not question the rule that non-patent procedural issues should generally be resolved under regional circuit law. Indeed, TechSearch does not even explain why it believes the use of a technical advisor is somehow unique to

patent law.[1] All that TechSearch argues, albeit repetitively, is that the application of regional circuit law in this case is inconsistent with the principle that patent law should be applied uniformly.

There are two fatal defects in this argument. First, the mere potential for variations in the law of regional circuits on procedural matters alone cannot justify the Federal Circuit creating and applying its own rules to the procedural decisions of district courts. If it were, there would be no aspect of such cases that would be beyond the control of Federal Circuit specific law. District courts would be required to set aside their normal procedural practices, and instead learn and apply a different set of procedural rules unique to patent cases that may end up at the Federal Circuit. This is not a correct statement of the law. *See Panduit Corp.*, 744 F.2d at 1574-1576 (stating Federal Circuit policy and bases therefor).

Second, although the creation of the Federal Circuit was motivated in part by a desire to improve the uniformity of patent law, this Court recently made clear that there are limits to the legal significance of this policy. *See Holmes Group v. Vornado Air Circulation Systems, Inc.*, 122 S. Ct. 1889, 1895 (2002) ("Our task here is not to determine what would further

1. It is manifest that cases other than patent cases involve difficult technology and thus properly share the same law regarding the use of technical advisors. Such cases include products liability cases, copyright cases, and contract disputes. Indeed, the leading cases cited by both parties on the issue of the use of technical advisors are not patent cases. *See, e.g., Reilly v. United States*, 863 F.2d 149 (1st Cir. 1988) and *Association Of Mexican-American Educators v. State of California*, 231 F.3d 572 (9th Cir. 2000).

Congress's goal of ensuring patent-law uniformity, but to determine what the words of the statute must fairly be understood to mean."). In *Holmes Group*, this Court ruled that, where patent claims appear in a counterclaim rather than the complaint, the Federal Circuit does not have appellate jurisdiction regardless of any desire for uniformity in patent cases. *Holmes Group* has been applied such that state courts and regional circuit courts now have jurisdiction over some cases involving patent claims. *See Green v. Hendrickson Publishers, Inc.*, 2002 WL 1397891, at *6-7 (Ind. June 27, 2002) (reasoning that, in view of *Holmes Group*, copyright and patent cases are not within the exclusive jurisdiction of the federal courts where such claims appear only in a counterclaim); *Telecomm Technical Servs., Inc. v. Siemens Rolm Comms., Inc.*, 295 F.3d 1249, 1252 (Fed. Cir. July 2, 2002) (applying *Holmes Group* to transfer a patent appeal to a regional circuit court for adjudication).

In view of these legal developments, it is clear that the policy of improving the "uniformity" of patent law is not the paramount principle that TechSearch makes it out to be. Further, this makes clear that TechSearch's approach is unworkable. Under *Holmes Group*, patent appeals are being adjudicated in the regional circuits and those courts will either apply their own procedural rules (making impossible TechSearch's plea in the Petition that Federal Circuit law uniformly govern the use of technical advisors in patent cases) or the regional circuits will have to apply Federal Circuit law to non-patent procedural rules, instead of their own body of law. Having all the regional circuits apply Federal Circuit law to procedural issues in patent cases only is awkward at best.

B. There Is No Split In The Circuits Justifying Supreme Court Review

TechSearch alleges that there is a split with "the Ninth Circuit and the Federal Circuit on one side and the Seventh, First, Third and D.C. Circuits on the other." Petition at 28. In fact, the circuits' rulings on the technical advisor issue are in harmony with each other and with this Court's decision in *In re Peterson*, 253 U.S. 300, 312-13 (1920), which affirms the inherent authority of courts to appoint technical advisors. The following is a review of the cases on which TechSearch relies for its claim that there is a circuit conflict compelling Supreme Court review.

1. Ninth Circuit

TechSearch argues that Ninth Circuit law relating to the use of technical advisors is split from other circuits by virtue of its *en banc* ruling in *Association Of Mexican-American Educators (AOMAE) v. State of California*, 231 F.3d 572 (9th Cir. 2000). In that case, the Ninth Circuit recognizes — as do all courts that have addressed the issue — that courts have the inherent authority to appoint a technical advisor under the proper circumstances. *Id.* at 590-91. The Court noted that such circumstances will be "rare," but will occur. *Id.* The Court rejected unsubstantiated complaints about the technical advisor and concluded that the district court did not abuse its discretion because there was no evidence to support any claim of error. *Id.* ("the absence of *any* evidence even suggesting an impropriety on the part of the district court militates against a conclusion that the court abused its discretion") (emphasis in original).

As noted above, in this case the Federal Circuit analyzed the technical advisor issue applying Ninth Circuit law. At the outset, the Federal Circuit noted that courts have inherent authority to use technical advisors in proper cases, but only in "exceptional" cases. App. 39-40 (*citing In re Peterson*, 253 U.S. 300, 312 (1920)). The Federal Circuit set forth guidelines for the use of technical advisors that it believed would be applied by the Ninth Circuit. App. 41-42. The Federal Circuit determined that TechSearch's claims of misconduct were unsupported by the evidence relied upon by TechSearch. App. 42-44. The Federal Circuit also reviewed the District Court's handling of the matter, including the District Court's seven page order regarding the technical advisor which stated that the technical advisor "may not contribute evidence" or "engage in any independent investigation." App. 43. The Federal Circuit concluded that the District Court exercised "great care" to ensure that the role of the technical advisor was properly limited. App. 43-44. Finally, the Federal Circuit held that, under all the circumstances, the District Court did not abuse its discretion.

Although TechSearch disagrees with the Federal Circuit's application of Ninth Circuit law to the facts of this case, such as TechSearch's absolutely baseless suggestion that the technical advisor performed "experiments," it does not identify any legal principle set forth in the Federal Circuit's opinion that conflicts with the decisions of any other court.

2. Seventh Circuit

The only Seventh Circuit case relied upon by TechSearch is *Edgar v. K.L.*, 93 F.3d 256 (7th Cir. 1996). *Edgar* did not involve a technical advisor, and is thus irrelevant. In *Edgar*,

an investigative panel was set up by the Court, pursuant to a stipulation of the parties, to collect evidence about the state's mental health care system, and issue factual findings on the disputed issues in the case for the record. *Edgar*, 93 F.3d at 257. Among other misconduct, the judge had lengthy off the record meetings with the panel which discussed the panel's evidence collection and its planned findings. *Id.* at 257-58.

There is a material difference between experts intended to submit factual findings for the record and a technical advisor who is barred from submitting evidence for the record. App. 38. Technical advisors function as a law clerk type advisor who does not contribute any evidence to the record. App. 38; *see also General Electric Co. v. Joiner*, 522 U.S. 136, 149 (1997) (Breyer, J., concurring) (noting that "specially trained law clerks" can be used to "overcome the inherent difficulty of making determinations about complicated scientific, or otherwise technical, evidence.").

The rules governing experts who make factual findings for the record after evidence gathering are, and should be, completely different from the rules governing a technical advisor who is forbidden from participating in the creation of the record. The *Edgar* case simply does not address the technical advisor issue, and thus creates no conflict.

3. First Circuit

To attempt to identify a circuit conflict based on First Circuit law, TechSearch relies on *United States v. Craven*, 239 F.3d 91 (1st Cir. 2001). However, *Craven*, like *Edgar*, involves an expert directed to perform an evidentiary investigation and expressly designated to prepare a report

with factual findings for the record. In *Craven*, the expert was specifically appointed to submit findings in a sentencing report pursuant to 18 U.S.C. § 3552(b). The First Circuit determined that the judge violated Section 3552(a) by having *ex parte* communications with the expert that were not placed in the report that was part of the record. The Court noted that the judge "relied heavily" on the unidentified findings which were not included in the Section 3552(b) report. *Id.* at 102-103. Because *Craven* does not involve a technical advisor, it cannot create a conflict in the law on that subject.

In fact, First Circuit law is in harmony with the law of all the other circuits on the use of technical advisors. First Circuit authority relating to the technical advisor issue was *relied* upon by the Ninth and Federal Circuit judges when they issued supposedly conflicting decisions. *See AOMAE*, 231 F.3d at 590-91 (relying on *Reilly v. United States*, 863 F.2d 149, 156 (1st Cir. 1988); App. 38, 40 (also relying on *Reilly*).

In *Reilly*, the First Circuit explained in detail why district courts have the inherent authority to appoint a technical advisor in proper cases. Specifically, the *Reilly* Court explained that such advisors may "act as a sounding board for the judge — helping the jurist to educate himself in the jargon and theory disclosed by the testimony and to think through the critical technical problems." *Reilly*, 863 F.2d at 158. In reaching this conclusion, the Court expressly drew upon *In re Peterson*, 253 U.S. 300, 312-13 (1920), which held that the power inherent in a court includes the power "to appoint persons unconnected with the court to aid judges in the performance of specific judicial duties, as they may arise in the progress of a cause." The *Reilly* Court noted that such action should be taken only where the district

court has determined that "the introduction of outside skills and expertise, not possessed by the judge, will hasten the just adjudication of a dispute." *Reilly*, 863 F.2d at 156-57.

Importantly, the Court in *Reilly* acknowledged the key distinction between technical advisors, on one hand, and experts intended to contribute to the record on the other: "Advisors of this sort are not witnesses, and may not contribute evidence." *Id.* at 157. In affirming the way the technical advisor was used by the district court, the First Circuit noted that the technical advisor did not submit evidence in the record and that there was simply no evidence to support the speculated wrongdoing. *Id.* at 159-60.

In sum, there is simply no meaningful distinction between the First Circuit's affirmance of the way the technical advisor was used in *Reilly* and the affirmances of the way the technical advisors were used in *AOMAE* and in this case. The only distinction from *Reilly* that TechSearch attempts to draw is that the case at bar supposedly involved evidence of "secret investigations done by the expert and secret meetings with the district court" whereas *Reilly* supposedly did not. Petition at 14. The allegation of "secret investigations" was correctly found to be baseless by the Federal Circuit as a matter of fact, and as discussed further below. The second allegation of "secret meetings" does not create a distinction because private meetings with the judge are a valuable part of the use of a technical advisor. As the First Circuit made clear, the purpose of a technical advisor is to meet one-on-one with a judge in a "frank and open fashion" thus, "helping the jurist to educate himself in the jargon and theory disclosed by the testimony and to think through the critical technical problems." *Reilly*, 869 F.2d at 158-60. Simply using the inflammatory term "secret" does not advance the analysis.

These meetings are no more "secret" than a judge's meetings with his or her law clerks, and no more objectionable.

4. Third Circuit

TechSearch cites two Third Circuit cases to try to create a "split" in authority. However, neither case involves the use of a technical advisor, and thus they are both irrelevant. *United States v. Green*, 544 F.2d 138, 146 (3d Cir. 1976) involved a testifying expert witness, and the Third Circuit *rejected* the allegation of wrongdoing. *Bennerson v. Joseph*, 583 F.2d 633 (3d Cir. 1978) involved a reference to a Special Master under Federal Rule of Civil Procedure 53 to issue a report deciding the case, wherein the Special Master committed errors in his analysis. Neither case relates to the use of a technical advisor.

5. D.C. Circuit

TechSearch relies on *United States v. Microsoft*, 147 F.3d 935 (D.C. Cir. 1998) to attempt to show a split in authority based on the law of the Circuit for the District Of Columbia. As in *Bennerson*, the *Microsoft* case involved an improper reference to a Special Master under Federal Rule of Civil Procedure 53, not the use of a technical advisor. Thus, it too is irrelevant. The D.C. Circuit rejected the "blanket" reference to a Special Master because, although it was purportedly designed to allow the Special Master only to supervise compliance with the district court's injunction, it improperly authorized the Special Master to make fundamental decisions about the interpretation of that injunction. The D.C. Circuit's *Microsoft* decision creates no conflict.

As demonstrated above, because there is no genuine conflict among the circuit courts on this issue, there is no basis for Supreme Court review. *See Layne & Bowler Corporation v. Western Well Works, Inc.*, 261 U.S. 387, 392-3 (1923) (Supreme Court review is unwarranted except "in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals."); *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 79 (1955).

II. THE FEDERAL CIRCUIT'S RULING DOES NOT CONFLICT WITH RULE 706

TechSearch alleges that the Federal Circuit's ruling somehow conflicts with Federal Rule of Evidence 706. However, that rule by its plain terms, including its eighteen references to the word "witness," does not cover technical advisors, who do not testify or otherwise contribute evidence to the record. TechSearch fails to cite even one case that suggests that Rule 706 covers technical advisors or otherwise regulates anything but expert *witnesses*. In fact, every case cited by TechSearch that addresses the issue of whether Rule 706 governs technical advisors, holds that Rule 706 does *not* govern technical advisors because they do not contribute evidence to the record and are not witnesses.

In *Reilly*, the Court analyzed this very question and concluded that Rule 706 is limited to expert witnesses, not technical advisors:

> Throughout its text, Fed.R.Evid. 706 refers not to "experts" generally, but to a more exclusive class: "expert witnesses." Because the plain

> language of a Civil Rule is the most reliable indicator of its meaning, we are constrained to conclude that the grasp of Rule 706 is confined to court-appointed expert witnesses; the rule does not embrace expert advisors or consultants.
>
> * * *
>
> This conclusion is buttressed by the text of the advisory committee (Notes) accompanying Rule 706.
>
> * * *
>
> Given the undeniable fact that, at common law, federal trial courts were empowered not only to designate expert witnesses, *e.g. Scott*, 298 F.2d at 930, but to appoint technical advisors as well, *see, e.g., Ex Parte Peterson*, 253 U.S. 300, 312-13, 40 S. Ct. 543, 547, 64 L. Ed. 919 (1920) (Brandeis, J.), the omission of any language limitative of the latter power is, we think, telling.

Reilly, 863 F.2d at 155.

In *AOMAE*, the Ninth Circuit explained that "Rule 706 applies to court-appointed *expert witnesses*, but not to technical advisors."[2] 231 F.3d at 590-91.

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2. Even the lone dissenting judge in the Ninth Circuit's *en banc* decision, *agreed* that, not only do district courts have the inherent authority to appoint technical advisors, but that Rule 706 does *not* apply to such technical advisors. *AOMAE*, 231 F.3d at 591.

In this case, the Federal Circuit recognized that the appointment of a technical advisor is "outside of the purview of Rule 706 of the Federal Rules of Evidence." App. 39-40. The Federal Circuit observed that there is not even conflicting authority on this point: "Courts and commentators agree that the court's inherent authority to appoint a technical advisor has not been displaced by the federal rules." App. 39-40.

Thus, every Court addressing this issue has understood Rule 706, as it is written: It only covers expert witnesses, not technical advisors. There simply is no conflict at all.

III. TECHSEARCH WAS NOT DEPRIVED OF ANY RIGHT TO A JURY TRIAL

TechSearch argues that the Federal Circuit's ruling in this case deprived it of its right to a jury trial. However, to have a right to a jury trial, a litigant, when confronted with a summary judgment motion, must present material evidence that would be sufficient to support a jury verdict in its favor. *Andersen v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-50 (1986).

Here, TechSearch failed utterly to present evidence which could raise a disputed issue of material fact. Based on a documentary summary judgment record, the District Court found non-infringement on multiple, independent grounds. *See, e.g.*, App. 78 ("Intel established beyond doubt and without cavil that its P6 microprocessor line is substantially different in material respects . . ."); App. 83 ("The Court finds that it is beyond dispute that the P6 microprocessors are not configured to emulate in the manner claimed and do not, therefore, infringe any one of the asserted claims."); App. 84 ("It is clear that none of the P6 microprocessors can possibly infringe the asserted claims, because it is beyond

question that the P6 microprocessors do not have a 'native mode' with microinstructions of N bits that is different from an emulation mode with microinstructions of M+N bits."); App. 87 ("It is, however, beyond cavil that the P6 products do not decode instructions as required by these claim elements either literally or under the doctrine of equivalents.").

In addition to the many non-infringement grounds found by the District Court, Intel had presented numerous other non-infringement grounds. The District Court did not reach those additional arguments because it stopped considering Intel's summary judgment arguments after it found multiple, independent grounds to resolve the case. App. 81.

The Federal Circuit affirmed the District Court on every one of the multiple non-infringement grounds based upon its "close" review of the documentary summary judgment record. App. 36. Although TechSearch previously argued that the Federal Circuit itself was somehow "tainted" by the technical advisor, the Federal Circuit had no contact at all with the technical advisor so this was an impossibility. TechSearch appears to have abandoned this argument.

Judge Dyk's concurrence at the Federal Circuit confirms that the District Court correctly determined that TechSearch had failed to present evidence to support its case. Judge Dyk supported an affirmance of the judgment because TechSearch had clearly failed to come forward with evidence to support its position. App. 46.

TechSearch submitted a petition for rehearing and a request for *en banc* review. In that petition, TechSearch again attempted to make some arguments about why it had presented evidence sufficient to support its case. Those arguments were again rejected.

In sum, TechSearch's argument that it has presented evidence that could support its case has been rejected repeatedly based upon reviews, re-reviews and detailed analyses of the documentary summary judgment record. The same conclusion of non-infringement has been reached every time. It is undisputed that the technical advisor did not contribute evidence to the record. TechSearch's argument that it was denied a right to a jury trial must be rejected because it failed to present evidence which could support its case in the face of a duly noticed motion for summary judgment. A grant of certiorari is unwarranted in such circumstances. *See Rice*, 349 U.S. at 79 (review granted only "in cases involving principles the settlement of which is of importance to the public, as distinguished from that of the parties"); *see also General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175, 178 (1938) (granting a writ of certiorari "would not be warranted merely to review the evidence or inferences drawn from it"); *United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts.").

CONCLUSION

For the foregoing reasons, Respondent Intel respectfully requests that the Petition be denied.

Respectfully submitted,

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APPENDIX

APPENDIX — TECHSEARCH'S OBJECTION TO THE APPOINTMENT OF EXPERT FILED DECEMBER 16, 1999

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

Case No. C 98-03484 WHO

TECHSEARCH L.L.C.

Plaintiff

v.

INTEL CORPORATION,

Defendant

TECHSEARCH'S OBJECTION TO APPOINTMENT OF EXPERT

To preserve its position on the record, TechSearch respectfully objects to the appointment of a court-appointed expert under the procedures required by the Court's Order of November 9, 1999.

Appendix

Respectfully submitted,

s/ Tyree P. Jones, Jr.
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